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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/724,406	11/28/00	FRANCISCO J	9632-006-999

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EXAMINER	
DAVIS,N	
ART UNIT	**PAPER NUMBER**
1642	4

DATE MAILED: 04/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)	
	09/724,406	FRANCISCO ET AL.	
	Examiner	Art Unit	
	Natalie A Davis	1642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *1-26-01* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-52* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claims *1-52* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
18) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1-19, drawn to a method of treatment or prevention of Hodgkin's disease, classified in class 424, subclass 193.1.

   II. Claims 20-33, drawn to a pharmaceutical composition, classified in class 387.1, subclass 387.1.

   III. Claims 34-52, drawn to an isolated nucleic acid, classified in class 536, subclass 23.1.

2. A. In the event applicant elects Group I, claims 1-19, applicant is required to elect a single species of protein used to treat or prevent Hodgkin's disease. Claims 1 and 7 are generic to a plurality of patentably distinct species, based on structural and functional differences, comprising the following:

   Species A, claim 9, drawn to SEQ ID NO: 4
   Species B, claim 9, drawn to SEQ ID NO: 6
   Species C, claim 9, drawn to SEQ ID NO: 8
   Species D, claim 9, drawn to SEQ ID NO: 12
   Species E, claim 9, drawn to SEQ ID NO: 14
   Species F, claim 9, drawn to SEQ ID NO: 16
   Species G, claim 10, drawn to SEQ ID NO: 20
   Species H, claim 10, drawn to SEQ ID NO: 22
   Species I, claim 10, drawn to SEQ ID NO: 24
   Species J, claim 10, drawn to SEQ ID NO: 28
   Species K, claim 10, drawn to SEQ ID NO: 30
   Species L, claim 10, drawn to SEQ ID NO: 32
   Species M, claim 11, drawn to a sequence with 95% identity to SEQ ID NO: 2
   Species N, claim 11, drawn to a sequence with 95% identity to SEQ ID NO: 10

Species O, claim 11, drawn to a sequence with 95% identity to SEQ ID NO: 18
Species P, claim 11, drawn to a sequence with 95% identity to SEQ ID NO: 26

B. In the event applicant elects Group II, claims 20-33, applicant is required to elect a single species of pharmaceutical composition. Claims 24 and 30-33 are generic to a plurality of patentably distinct species, based on structural and functional differences, comprising the following:
Species A, claims 20-23, wherein the pharmaceutical composition comprises an antibody
Species B, claim 25, wherein the pharmaceutical composition comprises a protein
Species C, claim 26, wherein the pharmaceutical composition comprises a protein comprising SEQ ID NO: 4
Species E, claim 26, wherein the pharmaceutical composition comprises a protein comprising SEQ ID NO: 6
Species F, claim 26, wherein the pharmaceutical composition comprises a protein comprising SEQ ID NO: 8
Species G, claim 26, wherein the pharmaceutical composition comprises a protein comprising SEQ ID NO: 12
Species H, claim 26, wherein the pharmaceutical composition comprises a protein comprising SEQ ID NO: 14
Species I, claim 26, wherein the pharmaceutical composition comprises a protein comprising SEQ ID NO: 16
Species J, claim 27, wherein the pharmaceutical composition comprises a protein comprising SEQ ID NO: 20
Species K, claim 27, wherein the pharmaceutical composition comprises a protein comprising SEQ ID NO: 22
Species L, claim 27, wherein the pharmaceutical composition comprises a protein comprising SEQ ID NO: 24
Species M, claim 27, wherein the pharmaceutical composition comprises a protein comprising SEQ ID NO: 28
Species N, claim 27, wherein the pharmaceutical composition comprises a protein

comprising SEQ ID NO: 30

Species O, claim 27, wherein the pharmaceutical composition comprises a protein comprising SEQ ID NO: 32

Species P, claim 26, wherein the pharmaceutical composition comprises a protein comprising SEQ ID NO: 4

Species Q, claim 28, wherein the pharmaceutical composition comprises a protein with 95% identity to SEQ ID NO: 2

Species R, claim 28, wherein the pharmaceutical composition comprises a protein with 95% identity to SEQ ID NO: 10

Species S, claim 29, wherein the pharmaceutical composition comprises a protein with 95% identity to SEQ ID NO: 18

Species T, claim 26, wherein the pharmaceutical composition comprises a protein with 95% identity to SEQ ID NO: 26

C. In the event applicant elects Group II, claims 34-52, applicant is required to elect a single species of isolated nucleic acid and recombinant cell. Claims 34-37, 42-46, and 51 are generic to a plurality of patentably distinct species, based on structural and functional differences, comprising the following:

Species A, drawn to SEQ ID NO: 1

Species B, drawn to SEQ ID NO: 3

Species C, drawn to SEQ ID NO: 5

Species D, drawn to SEQ ID NO: 7

Species E, drawn to SEQ ID NO: 9

Species F, drawn to SEQ ID NO: 11

Species G, drawn to SEQ ID NO: 13

Species H, drawn to SEQ ID NO: 15

Species I, drawn to SEQ ID NO: 17

Species J, drawn to SEQ ID NO: 19

Species K, drawn to SEQ ID NO: 21

Species L, drawn to SEQ ID NO: 23

Species M, drawn to SEQ ID NO: 25

Species N, drawn to SEQ ID NO: 27

Species O, drawn to SEQ ID NO: 29

Species P, drawn to SEQ ID NO: 31

Species AA, drawn to SEQ ID NO: 2

Species BB, drawn to SEQ ID NO: 4

Species CC, drawn to SEQ ID NO: 6

Species DD, drawn to SEQ ID NO: 8

Species EE, drawn to SEQ ID NO: 10

Species FF, drawn to SEQ ID NO: 12

Species GG, drawn to SEQ ID NO: 14

Species HH, drawn to SEQ ID NO: 16

Species II, drawn to SEQ ID NO: 18

Species JJ, drawn to SEQ ID NO: 20

Species KK, drawn to SEQ ID NO: 22

Species LL, drawn to SEQ ID NO: 24

Species MM, drawn to SEQ ID NO: 26

Species NN, drawn to SEQ ID NO: 28

Species OO, drawn to SEQ ID NO: 30

Species PP, drawn to SEQ ID NO: 32

Species 1, claim 47, drawn to a sequence with 95% identity to SEQ ID NO: 2

Species, 2, claim 47, drawn to a sequence with 95% identity to SEQ ID NO: 10

Species 3, claim 48, drawn to a sequence with 95% identity to SEQ ID NO: 18

Species 4, claim 48, drawn to a sequence with 95% identity to SEQ ID NO: 26

Species 5, claim 49, drawn to SEQ ID NO: 2

Species 6, claim 49, drawn to SEQ ID NO: 10

Species 7, claim 50, drawn to SEQ ID NO: 18

Species 8, claim 50 drawn to SEQ ID NO: 26

Species 9, drawn to a recombinant cell containing a vector comprising SEQ ID NO: 1

Species 10, drawn to a recombinant cell containing a vector comprising SEQ ID NO: 3

Species 11, drawn to a recombinant cell containing a vector comprising SEQ ID NO: 5

Species 12, drawn to a recombinant cell containing a vector comprising SEQ ID NO: 7

Species 13, drawn to a recombinant cell containing a vector comprising SEQ ID NO: 9

Species 14, drawn to a recombinant cell containing a vector comprising SEQ ID NO: 11

Species 15, drawn to a recombinant cell containing a vector comprising SEQ ID NO: 13

Species 16, drawn to a recombinant cell containing a vector comprising SEQ ID NO: 15

Species 17, drawn to a recombinant cell containing a vector comprising SEQ ID NO: 17

Species 18, drawn to a recombinant cell containing a vector comprising SEQ ID NO: 19

Species 19, drawn to a recombinant cell containing a vector comprising SEQ ID NO: 21

Species 20, drawn to a recombinant cell containing a vector comprising SEQ ID NO: 23

Species 21, drawn to a recombinant cell containing a vector comprising SEQ ID NO: 25

Species 22, drawn to a recombinant cell containing a vector comprising SEQ ID NO: 27

Species 23, drawn to a recombinant cell containing a vector comprising SEQ ID NO: 29

Species 24, drawn to a recombinant cell containing a vector comprising SEQ ID NO: 31

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. Since claim 20 is drawn to a pharmaceutical composition and claims 21-23 are dependant upon claim 20, claims 21-23 are interpreted as a pharmaceutical composition and not as a method.

4. Inventions I-III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the inventions of Groups II-III may be used for a number of different processes that are very much unrelated. For example, the nucleotide of Group III may not only be used in the method of Group I, but may also be used to isolate a protein. The method of Groups I may be practiced using various therapeutic agents and do not necessarily have to be used with the inventions of Groups II-III. As indicated by the claims, structurally and functionally different nucleotide products may be used in the method of invention I.

5. Inventions I-III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the inventions of Groups II and III are functionally and structurally different, each invention requires different reagents and steps to make and characterize them, or different methods of use that do not share common steps or reagents and rely on different endpoints.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, divergent subject matter, and require different search strategies, restriction for examination purposes as indicated is proper.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Davis whose telephone number is 703-308-6410. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4315 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Natalie A. Davis
March 27, 2001

GEETHA P. BANSAL
PRIMARY EXAMINER